

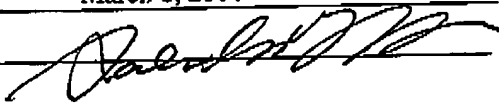
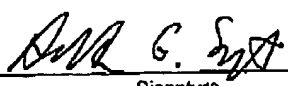
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
transmitted via facsimile to (571) 273-8300		083022-0272515	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number	Filed
on <u>March 8, 2006</u>		10/007,355	November 7, 2001
Signature <u></u>	First Named Inventor	Mitchell D. Eggers	
Typed or printed name <u>Sachiko Y. Snedden</u>	Art Unit	1743	Examiner
			Alexander, Lyle
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u></u>	
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Anthony G. Smyth	
<input checked="" type="checkbox"/> attorney or agent of record.	55636	650-233-4802	
Registration number		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		March 8, 2006	
Registration number if acting under 37 CFR 1.34		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 083022-0272515

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re application of: Eggers, Mitchell D.
Application No.: 10/007,355Confirmation No. : 3570
Group Art Unit.: 1743

Filed: November 7, 2001

Examiner: ALEXANDER, Lyle

Title: SAMPLE CARRIER

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**Pre-Appeal Brief Request for Review**

This brief is submitted concurrently with a timely-filed Notice of Appeal in the above-listed Application. The Notice of Appeal is filed in response to the Final Office Action mailed on December 8, 2005.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8 and/or 1.10*

(When using Express Mail, the Express Mail label number is mandatory; Express Mail certification is optional.)

I hereby certify that, on the date shown below, this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office, (571) 273-8300.

Date: March 8, 2006

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SACHIKO Y. SNEDDEN

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

REMARKS

Claims 1-40 and 58-69 are pending in the present application, claims 41-57 having been withdrawn from consideration by the Examiner. Applicants intend to address a provisional double patenting rejection in the Final Office Action ("the FOA") when the Examiner acknowledges that allowable subject matter has been recited in the present application.

As set forth in the FOA, claims 1-40 and 58-69 stand rejected under 35 U.S.C. § 102(e) as anticipated by WO 01/31333 A1 to Milosavijevic et al. ("the '333 publication"). Claims 1-14, 20-35, 58-66, and 69 stand rejected under 35 U.S.C. § 102(e) as anticipated by WO 01/31317 A1 to Hogan et al. ("the '317 publication"). Additionally, claims 15-19, 36-40, 67, and 68 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the '317 publication.

The Prior Art Does Not Teach Or Suggest all Elements of The Independent Claims

In the FOA, the Examiner continues to assert that the cited prior art teaches discrete sample nodes that are removably attached to a structural array at respective attachment points as recited in the claims. Applicant respectfully submits that the rejections are based on clear error of fact and are consequently improper.

The claims of the present invention require that discrete sample nodes are attached to a structural array and that the discrete sample nodes are removably attached. The cited publications are directed particularly to "punch card" systems (*See, e.g.*, the descriptions at page 18, lines 6-11, of the '313 publication, and at page 4, lines 5-18, of the '317 publication). In accordance with the techniques taught in the cited publications, sample material is blotted onto a punch card substrate (designated by reference numeral 24 in FIG. 2) and diffuses through the substrate; this creates a universal or omnibus sample distributed across the substrate. A pellet or plug (designated by reference numeral 100 in FIG. 2) may be punched from anywhere on the substrate, irrespective of the uniformity of the sample material's diffusion, at a later time.

In the FOA, the Examiner argues that "the cited art teaches discrete sample[s] placed into unique and discrete containers for subsequent analysis," and that such samples are "indistinguishable from the instant claims" (FOA at page 4, first paragraph). Thus, the Examiner's argument admits teachings in the cited art that discrete sample nodes are created only after *detachment* – by punching – of pellets or plugs from a monolithic card and their placement

in unique and discrete containers. These detached samples are clearly distinguishable from discrete sample nodes that are removably *attached* to a structural array as recited in the present claims. Therefore, the rejections are improper.

The Examiner also argues that “the cited prior art teaches sample placement nodes that do not mix with other applied samples and meet the claimed ‘discrete’ limitation” (FOA, page 3, paragraph 3). This argument is specious since the characteristics of samples blotted on the punch card do not affect whether the alleged sample nodes are discrete. The Examiner alleges that the prior art teaches the creation of discrete sample nodes by the punching of pellets or plugs from a sample card. Since it is conceivable that multiple pellets or plugs punched from the Examiner’s alleged “discrete” sample placements could be combined into one sample well, the discreteness of individual sample blots cannot be said to be determinative of whether a plurality of pellets or plugs punched from that punch card are maintained as discrete sample nodes.

In contrast to the fair teachings of the cited publications, each discrete sample node attached to a structural array is described and claimed in the present application as being operative to carry a “discrete” sample. The punch card system taught in the cited publications must sever or excise a bit of sample material from an otherwise unified or consolidated substrate, and does not contemplate discrete samples as described and claimed in present application. The Examiner has identified this deficiency in the ‘317 publication as set forth on page 4 of the Office Action mailed March 31, 2005 (acknowledging that the punch head assembly “punches out *a portion of the sample*”). Accordingly, a plug punched from a punch card, failing to carry a “discrete” sample as described and claimed in the present application, is not equivalent to a “discrete sample node” as recited in the pending claims.

Further, the cited publications fail to teach or even to suggest a structural array to which each of a plurality of discrete sample nodes is removably attached at a respective attachment point. The Examiner maintains, without citation to the references, that the term “attachment points” is “read properly as a point of attachment which is clearly taught by the cited prior art” (FOA at page 4, first paragraph). Examiner maintains this position even though a declaration provided to the Examiner by Mr. Michael Hogan, coinventor in the cited references, confirms that the references do not teach the recited attachment points. In the FOA, the Examiner dismisses the Hogan declaration based on the Examiner’s perception of a lack of clarity as to “how Mr. Hogan has read/understood/interpreted” the claimed attachment points (FOA at page

4, paragraph 2). Absent any identifiable factual support that the references teach a structural array having attachments points to which each of a plurality of discrete sample nodes is removably attached, the Examiner erred in dismissing objective evidence to the contrary in the form of the Hogan declaration. Therefore, Applicant respectfully submits that the Examiner's rejections of the claims are improper.

CONCLUSION

Applicants submit that the cited publications fail to teach or to suggest at least the foregoing structural elements as recited in every pending independent claim (claims 1, 20 and 58). Accordingly, the cited publications are insufficient to anticipate any of the pending independent claims and the rejections of claims 1-40 and 58-69 under 35 U.S.C. § 102(e) are therefore improper. At least for the reasons set forth above with specific reference to independent claims 1, 20, and 58, their respective dependencies are also allowable. Further, claims 2-19, 21-40, and 59-69 recite additional features and combinations of elements, and Applicants submit that these claims are additionally allowable for their respective recitations as well.

It is respectfully submitted that it is clear that the Examiner erred in rejecting the claims because the references do not teach every aspect of the claimed invention either explicitly or impliedly. Therefore, the rejections are improper and should be withdrawn. Further, the claims are believed to be in form for allowance, and an indication to that effect is hereby solicited.

Date: March 8, 2006

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